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FACSIMILE INFORMATION SHEET

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Total Number of Pages: 12 (including Information Sheet)

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{W0048960.1}

Plant Patent Application
Serial No. 09/664,247
Confirmation No. 4085
Attorney Docket No.: 2384-001440

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit 1661	:	
In re Application of	:	
WILHELM ELSNER	:	**VARIETY OF GERANIUM NAMED 'PENDEC'**
Serial No. 09/664,247	:	
Filed September 18, 2000	:	
Examiner - S. McCormick	:	Pittsburgh, Pennsylvania March 13, 2003

REQUEST TO REINSTATE APPEAL

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action of March 12, 2003, Applicant requests that the Appeal in the above-identified application be reinstated. Accompanying this Request is a Supplemental Appeal Brief in compliance with 37 C.F.R. § 1.193(b)(2).

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to Commissioner of Patents, Washington, D.C. 20231 on the date shown below.

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Helen L. Gerace
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{W0048846.1}

All fees relating to the Appeal have been paid. However, the Commissioner of Patents and Trademarks is hereby authorized to charge any additional fees which may be required to Deposit Account No. 23-0650.

Respectfully submitted,

WEBB ZIESENHEIM LOGSDON
ORKIN & HANSON, P.C.

By _____

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Plant Patent Application
Serial No. 09/664,247
Confirmation No. 4085
Attorney Docket No.: 2384-001440

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Group Art Unit 1661	:	
In re Application of	:	
WILHELM ELSNER	:	**VARIETY OF GERANIUM NAMED 'PENDEC'**
Serial No. 09/664,247	:	
Filed September 18, 2000	:	
Examiner - S. McCormick	:	Pittsburgh, Pennsylvania March 13, 2003

SUPPLEMENTAL APPEAL BRIEF

Commissioner for Patents
Washington, D.C. 20231

Sir:

This Supplemental Appeal Brief is submitted in response to the Office Action of March 12, 2003. The headings, subject matter and arguments set forth in the Appeal Brief filed August 26, 2002 and Reply Brief filed February 24, 2003 are incorporated herein by reference.

The headings used hereinafter and the subject matter set forth under each heading are in accordance with 37 C.F.R. § 1.192(c).

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03/13/03 Helen L. Gerace
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Helen L. Gerace
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{W0048864.1}

I. REAL PARTY IN INTEREST

Appellant incorporates by reference the subject of the corresponding heading from the Appeal Brief filed August 26, 2002.

II. RELATED APPEALS AND INTERFERENCES

Appellant incorporates by reference the subject of the corresponding heading from the Appeal Brief filed August 26, 2002.

III. STATUS OF CLAIMS

Appellant incorporates by reference the subject of the corresponding heading from the Appeal Brief filed August 26, 2002.

Claim 1 is reproduced in Appendix A which is attached hereto.

IV. STATUS OF AMENDMENTS

Appellant incorporates by reference the subject of the corresponding heading from the Appeal Brief filed August 26, 2002.

V. SUMMARY OF THE INVENTION

Appellant incorporates by reference the subject of the corresponding heading from the Appeal Brief filed August 26, 2002.

VI. ISSUE PRESENTED

Appellant incorporates by reference the subject of the corresponding heading from the Appeal Brief filed August 26, 2002.

VII. GROUPING OF CLAIMS

Appellant incorporates by reference the subject of the corresponding heading from the Appeal Brief filed August 26, 2002.

VIII. ARGUMENTS

Simply stated it is illogical and bad law to indirectly combine a non-enabling disclosure and a non-prior art foreign sale to reject a claim when such a direct combination would be in clear violation of the Patent Statute.

Appellant incorporates by reference the subject of the corresponding heading from the Appeal Brief filed August 26, 2002 and the entirety of the Reply Brief filed February 24, 2003, all of which remain relevant to this Appeal.

In addition, Appellant submits the following comments in response to the two points raised as "Rebuttal to Reply Brief" in the March 12, 2003 Office Action.

First, the Examiner disagrees with the characterization of the amount of information regarding the application for Community Plant Variety Rights in Europe for 'Pendec' bearing Serial Number 97/0950 that was available on September 3, 1997 in the Official Gazette of the Community Plant Variety Office. However, as noted in the March 12, 2003 Office Action, the Examiner and the Appellant agree that regardless of the amount of written information (large or small) on a variety of geranium named 'Pendec', the publication would be non-enabling.

Second, the Examiner disagrees with assertions that the *LeGrice* court had evidence of commercial use of the claimed rose plants. Appellant agrees that the stipulated facts upon which the *LeGrice* decision was based did not include a stipulation that the claimed rose plants were "on sale" anywhere. However, the stipulated facts are replete with evidence of commercial availability and public use of the claimed plants. See pages 3-4 of the Reply Brief. Mr. LeGrice did not stipulate to the sale of the rose plants, but such a stipulation was not necessary to parallel the present case. In addition, the lack of physical evidence in the form of the catalogs themselves is not itself indicative that the claimed plants were unavailable commercially. That evidence is found within the stipulated facts of *LeGrice*.

Naturally, there was no discussion about enablement of the printed publications (the catalogs) based on public availability of the rose plants in the *LeGrice* decision reported by the CCPA. The public availability of the rose plants outside the United States was already deemed irrelevant to the issue of novelty at the Board of Appeals. Moreover, the catalogs at least implicitly contained such evidence of public availability of the plants (in addition to the stipulated facts of distribution thereof), yet no enablement of the catalogs by such evidence was found.

IX. CONCLUSION

The asserted enablement of a printed publication by "non-prior art" (sale outside the United States) is an attempt to thwart the statutory requirement that the plant itself be present in the United States to bar a plant patent in light of today's understanding of plant genetics.

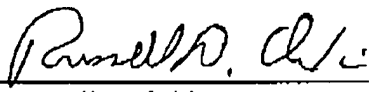
Appellant urges the Board to follow the established federal court precedent of *LeGrice* and reverse the novelty rejection in the present application.

Filed concurrently herewith is a Request for Reinstatement of Appeal.

All fees relating to this Appeal have been paid. However, the Commissioner of Patents and Trademarks is hereby authorized to charge any additional fees which may be required to Deposit Account No. 23-0650. An original and two copies of this Supplemental Appeal Brief are enclosed.

Respectfully submitted,

WEBB ZIESENHEIM LOGSDON
ORKIN & HANSON, P.C.

By 

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Plant Patent Application
Serial No. 09/664,247
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Attorney Docket No.: 2384-001440

APPENDIX A

1. A new and distinct variety of geranium plant named 'Pendec' as described and illustrated herein.

Plant Patent Application
Serial No. 09/664,247
Confirmation No. 4085
Attorney Docket No.: 2384-001440

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application No. 09/664,247

Filing Date: September 18, 2000

Appellant: ELSNER, WILHELM

Examiner - Susan B. McCormick

Art Unit 1661

Pittsburgh, Pennsylvania
March 13, 2003

REQUEST FOR ORAL HEARING

Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicant hereby reiterates its request for an oral hearing in the Appeal of the above-identified plant patent application.

The fee of $280.00 for this Request for Oral Hearing was submitted with Applicant's original Request For Oral Hearing on February 24, 2003. However, the Commissioner for Patents is hereby authorized to charge any additional fees associated with this communication to Deposit Account No. 23-0650. An original and two copies of this Request are enclosed.

Respectfully submitted,
WEBB ZIESENHEIM LOGSDON
ORKIN & HANSON, P.C.

By _____

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{W0048849.1}

Plant Patent Application
Serial No. 09/664,247
Confirmation No. 4085
Attorney Docket No.: 2384-001440

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application No. 09/664,247	:
Filing Date: September 18, 2000	:
Appellant: ELSNER, WILHELM	:
Examiner - Susan B. McCormick	:
Art Unit 1661	:

Pittsburgh, Pennsylvania
March 12, 2003

REQUEST FOR SPECIAL HANDLING

Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicant hereby reiterates its request for oral argument through an expedited hearing and that the subject appeal be heard at the same time or as close as possible to the following cases having a hearing date of March 26, 2003:

Application SN 09/286,130
Filed: April 12, 1999
For: Floribunda Rose Plant Named KORrogilo
Applicant: Wilhelm Kordes
Attorney Ref. No.: 6507-51530

And

Application SN 09/267,559
Filed: March 12, 1999
For: Hybrid Tea Rose Plant Named JACopper
Applicant: Keith W. Zary
Attorney Ref. No. 2747-51708

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Helen L. Gerace
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(W0048851.1)

Each of these applications and Applicant's present application have a single claim which stands rejected upon a single, identical ground, namely, the plant of each respective application was described in a foreign publication more than one year before the application was filed (which description was admitted standing alone not to be sufficient to have enabled one skilled in the art to practice the claimed invention), and the plant was on sale in a foreign country (but not in the United States) more than one year before the filing date.

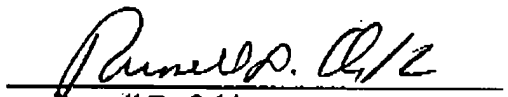
This ground for rejection has adverse implications for the entire patent system, as any non-enabling publication relating to a product coupled with the availability of a product in any country outside of the United States, both more than a year before the United States application filing date, would now be prior art.

An expedited hearing is requested because this single issue is present, we are told, in approximately two hundred plant patent applications and is a new basis for rejection raised for the first time in a plant patent application in 2000. The Webb Law Firm has an estimated thirty or more plant patent applications pending that have been or will be subject to a 35 U.S.C. § 102(b) rejection upon the basis utilized in the applications of this petition. The Webb Law Firm has received direction from Applicants outside of the United States to abandon several applications which have been rejected upon the basis utilized in the subject applications because of the costs associated with an appeal, and has also received indication in other instances that applications for plant patents would not be filed because of the likelihood that the applications would be rejected under 35 U.S.C. § 102(b) because the plant of the prospective application had been the subject of a breeder's rights application and on sale in a foreign country more than one year before a United States plant patent application could be filed. Without the prospect of obtaining a plant patent, the introduction of many ornamental or commercially valuable plants will not be made to the detriment of the American public.

For the reasons set forth in the briefs in the appealed applications, it is believed the rejections are not in accordance with the law, and because of the large number of applications involved and the economic damage that will result unless the current policy is rectified, an early hearing and joint consideration of these appeals is believed to be in order.

Respectfully submitted,

WEBB ZIESENHEIM LOGSDON
ORKIN & HANSON, P.C.

By 

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